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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,827	01/24/2001	Norbert Miller	SWR-0038	5172

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/769,827	MILLER, NORBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20010124</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

Art Unit: 3629

### **Claim Objections**

1. Claim 10 is objected to because of the following informalities: The examiner is not sure if the term "enquiry" is correctly spelled. Should this be "inquiry"? Appropriate correction is required.

### **Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6,8,9,11,12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiappetti (4338587).

For claims 1-4,6,11, Chiappetti discloses a method of automatic toll collection. Chiappetti discloses the step of a user selecting a product or service (a person deciding to use the mobile vehicle ID unit in their vehicle and having one installed so they can quickly pass through a toll plaza). See column 4, line 67 to column 5, line 3 where it is disclosed that the provider assigns an authorization code that is stored in a memory module (the mobile vehicle ID unit). The code is also sent to the code verification system. The code verification

Art Unit: 3629

system is the automated system of the toll plaza that interacts with the mobile vehicle ID unit. When the user enters a given region of the toll plaza, a non-contact code verification is performed and the user is granted access to the toll road. Applicant should read the entire patent but attention is brought to column 1, line 63 to column 2, line 20; column 2, lines 55-63; column 4, line 67 to column 5, line 9; column 5, lines 40-54.

For claim 5, the authorization code is only valid for a limited area (the specific toll road being used).

For claim 8, once the mobile vehicle ID unit receives a signal from the toll plaza system, the unit is activated and sends a signal to the toll plaza system. This constitutes selective activation.

For claims 9, the claimed processing system is satisfied by the circuitry/memory system disclosed by Chiappetti.

For claim 12, see column 5, lines 2-3.

4. Claims 1-6,8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassett (5805082).

For claims 1-4,6,11, Hassett discloses a method of automatic toll collection by use of an in vehicle processor. Hassett discloses the step of a user selecting a product or service (a person deciding to use the in vehicle processor in their vehicle and having one installed so they can quickly pass through a toll plaza). See column 12, lines 65-67 where it is disclosed that the provider assigns an authorization code that is stored in a memory module (the in vehicle processor). The code is also sent to the code verification system. The code

Art Unit: 3629

verification system is the automated system of the toll plaza that interacts with the in vehicle processor. When the user enters a given region of the toll plaza, a non-contact code verification is performed and the user is granted access to the toll road.

For claim 5, the authorization code is only valid for a limited area (the specific toll road being used).

For claim 8, Hassett discloses selective activation in the sense that once the unit recognizes that it is approaching a toll plaza, a signal is sent out. This constitutes selective activation.

For claims 9,10, the claimed processing system is considered to be the computer system of the toll plaza. The toll plaza computer system is equipped with data telecommunications interfaces (transfer of data to charge a credit card for the toll money, column 4, lines 24-28). The computer system is also capable of providing inquiry analysis or availability checking (account balances), can generate and transmit service offers, etc.. The examiner has interpreted claim 10 to be reciting the intended use of the system and the system of Hassett is fully capable of performing the intended use recitations.

For claim 12, an account statement is automatically generated in the vehicle so the driver can see how much is left in the account based on the most recent deduction.

5. Claims 1,5-12, are rejected under 35 U.S.C. 102(e) as being anticipated by Pugliese, III et al. (US2001/0016825).

Art Unit: 3629

For claims 1,6-11, Pugliese discloses a method bypassing a rental/check in counter by using an automated system. The step of a user selecting a product or service is disclosed by the user reserving an airline seat, car rental, or making a hotel reservation online (ATM). The provider assigns an ID code for the reservation and stores it in a memory module (the ID card). The provider reserves the item (airline seat, hotel room, rental car) and stores the ID number. When the user desired to gain access to the item reserved, a non contact verification is conducted. This is by way of an optical retinal scan (non contact) or by way of an optical reader to read the card (also non contact), see paragraph 60. Once the computer system determines the user is an authorized user access is granted (see paragraph 90).

For claim 5, the access is granted for a limited area (hotel room) and for a limited time.

For claim 12, see paragraph 16, where it is disclosed that a receipt is printed for the customer.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER